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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/722,147   | 11/25/2000  | Paul Lapstun         | NPS018US            | 4018             |
| 24011  | 7590        | 02/27/2003           |                     |                  |
| SILVERBROOK RESEARCH PTY LTD<br>393 DARLING STREET<br>BALMAIN, 2041<br>AUSTRALIA |             |                      | EXAMINER            |                  |
|  |             |                      | KAO, CHIH CHENG G   |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 2882                 |                     |                  |
| DATE MAILED: 02/27/2003  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/722,147             | LAPSTUN ET AL.      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Chih-Cheng Glen Kao    | 2882                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.<br> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 1-3 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US Patent 5995105) in view of Liddiard et al. (US Patent 5465080) and Coleman (US Patent 5852286).

Reber et al. discloses a viewing device (Fig. 8) including at least one sensor for sensing coded data and for generating first data (Fig. 8, #98), a transmitter and receiver (Fig. 8, #90 and 96) to and from an electronic network, at least one display device (Fig. 8, #94), a printer mechanism (Fig. 1, #38) printing data based on visual information (col. 5, lines 37-46), a user interface and control (Fig. 8, #92), wherein visual info represents a portion of an electronic document replicating at least some of the interface (Fig. 3) visible to the unaided human eye (Fig. 1, #14) and operative to sense data when positioned over the substrate (col. 9, lines 34-35).

However, Reber et al. does not disclose a transmitter and receiver to and from a computer system, nor generating first data based at least partly on the coded data.

Liddiard et al. teaches a transmitter and receiver to and from a computer system (col. 5, lines 1-5). Coleman teaches generating first data based at least partly on the coded data (col. 2, lines 35-45).

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It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the computer system of Liddiard et al. with the system of Reber et al., since a network is essentially a computer as shown by Liddiard et al. (col. 5, lines 1-5). One would be motivated to have a computer system to store memory and process information to various from other transmitters and send information out to the receivers.

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have data partly based on coded data of Coleman with the system of Reber et al., since one would be motivated to have other information light ambient light to reduce signal-to-noise ratio of circuitry, which can cause a faulty reading as implied from Coleman (col. 1, lines 50-60).

Also note that recitations, such as printing on the substrate or overlapping the display device, sensor, and coded data, with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

2. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Liddiard et al. and Coleman as applied to claim 3 above, and further in view of Tamaru (US Patent 4888479).

Reber et al. in view of Liddiard et al. and Coleman suggests a system as recited above.

However, Reber et al. does not disclose the user interface with a touch sensitive overlay.

Tamaru teaches a touch sensitive overlay (Title and Fig. 1).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the touch sensitive overlay of Tamaru with the suggested system of Reber et al. in view of Liddiard et al. and Coleman, since one would be motivated to have the overlay as a way for a man and machine to interface with each other as implied from Tamaru (col. 1, lines 15-20).

Also note that recitations with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

***Response to Arguments***

3. The objection to the claims in the Office Action mailed 10/4/02 is withdrawn in light of the amendment filed 12/3/02.

4. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

With regards to Reber et al., Reber et al. does have the sensor, display, and printer as noted above. With regards to Liddiard et al., Liddiard et al. just shows that an electronic network can use a computer system.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (703) 605-5298. The examiner can normally be reached on M - Th (8 am to 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (703) 305-3492. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



gk  
February 23, 2003

  
ROBERT KIM  
FEB 23 2003  
REC'D - 722-147